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EXAMINER

KEASEL, ERIC S

ART UNIT PAPER NUMBER

3754

DATE MAILED: 02/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-3, 6, 7, 9, 10, 13, and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by MacDonald (US Patent Number 4,057,217).

MacDonald discloses an arrangement for closing a through flow opening in a throttle valve connection piece comprising: a throttle valve shaft (19) positioned over and transverse to said through flow opening, said shaft pivotably mounted to said throttle valve connection piece (see Fig. 2); and a throttle valve (21) comprising a receiving opening running a length of and planar to said valve, said receiving opening comprising an interior opening (22) wherein said shaft is mounted such that said valve selectively closes said flow opening, and one or more recesses (35, 37) into said interior opening wherein said valve is connected to said shaft by at least one welding (49); wherein said valve comprises walls forming a hub, said hub comprising said receiving opening; wherein said throttle valve comprises a connecting element (41, 43) connected to said throttle valve and projecting into said recess, said connecting element comprising a material weldable to said throttle valve shaft; wherein said connecting element comprises two connecting elements (41, 43) arranged firmly connected to said throttle valve and projecting, in opposite directions to one another, tangential to said throttle valve shaft, and into

said recesses (35, 37); wherein said shaft further comprises opposing ends projecting into recesses within a housing of said throttle valve connection piece (see Fig. 2); wherein said connecting element extends, along said valve shaft, a substantial length of said recess; further comprising a plurality of connecting elements adjacently arranged within said recess and along said throttle valve shaft; wherein said throttle valve comprises a lightweight metal; and wherein said throttle valve shaft comprises steel.

3. Claims 1-4 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Obermaier (US Patent Number 3,675,681).

Obermaier discloses an arrangement for closing a through flow opening in a throttle valve connection piece comprising: a throttle valve shaft (35) positioned over and transverse to said through flow opening, said shaft pivotably mounted to said throttle valve connection piece; and a throttle valve (33) comprising a receiving opening running a length of and planar to said valve, said receiving opening comprising an interior opening wherein said shaft is mounted (see Fig. 2) such that said valve selectively closes said flow opening, and one or more recesses (near 34) into said interior opening wherein said valve is connected to said shaft by at least one welding (see column 2, line 19); wherein said valve comprises walls forming a hub, said hub comprising said receiving opening; wherein said throttle valve comprises a connecting element (34) connected to said throttle valve and projecting into said recess, said connecting element comprising a material weldable to said throttle valve shaft; and wherein said connecting element is welded to said throttle valve shaft at its projection within said recess.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 16-21 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over MacDonald.

Regarding “prestress” and the various welding methods, the patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product in the prior art, the claim is unpatentable even though the prior product was made by a different process (see MPEP 2113).

6. Claims 11, 12, and 16-21 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Obermaier.

Regarding “injection molding” and “encapsulation” during its manufacture, “prestress” and the various welding methods, the patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product in the prior art, the claim is unpatentable even though the prior product was made by a different process (see MPEP 2113).

7. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over MacDonald.

MacDonald discloses the connecting element welded to the valve rather than the valve shaft. The examiner took official notice that such a location of the weld is an old and well-

Art Unit: 3754

known expedient in the art. Since applicant did not traverse the examiner's assertion, the location of the weld being an old and well-known expedient in the art is taken to be admitted prior art.

8. Claims 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Obermaier.

Obermaier is silent as to the material selections set forth in claims 13-15. The examiner took official notice that these material selections are old and well-known expedients in the art. Since applicant did not traverse the examiner's assertion, the material selections set forth in claims 13-15 being old and well-known expedients in the art is taken to be admitted prior art.

Response to Arguments

9. Applicant's arguments filed October 6, 2004 have been fully considered but they are not persuasive.

Applicant argues that the recesses of MacDonald extend completely through the throttle valve and do not expose the shaft. The examiner agrees with the first portion of the statement but disagrees with the second portion of the statement. The recesses of MacDonald clearly intersect the receiving opening. More importantly, there is no recited claim limitation that matches applicant's statement regarding any perceived differences between the disclosure of MacDonald and claim 1.

Applicant argues that there is no direct welding of the shaft to the valve in MacDonald. However, it should be noted that the disclosure of applicant does not have the shaft directly welded to the valve either (as intermediate piece is required). This is why the claim recitation broadly recited that "said valve is connected to said shaft by at least one welding". This must be

Art Unit: 3754

read as the weld directly connects intermediate parts in the connection of the valve to the shaft.

MacDonald clearly meets this recitation.

Applicant argues that claim 3 requires that the connecting element is welded to the shaft. The examiner disagrees. The claim limitation requires that the material is weldable (i.e. capable of being welded) to the shaft. The connecting element of MacDonald is made of a material that is capable of being welded to the shaft.

Re claims 6 and 10, applicant argues that the claim limitation requires multiple connecting elements in a single recess. The examiner disagrees. Applicant has recited “one or more recesses” in the claims and also “said recess”. This inconsistency in terminology causes some confusion, but it would appear that “said recess” refers to (and is used interchangeably with) the previously recited “one or more” recesses.

Applicant argues that the large recess in the valve of Obermaier can not be read as the receiving opening for the shaft. The examiner disagrees. The broadly recited “receiving opening” does not require that the shaft be inserted into a round hole.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

Art Unit: 3754

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric Keasel whose telephone number is (571) 272-4929. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Mar can be reached on (571) 272-4906. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Eric Keasel 4 FEB 2005

Eric Keasel
Primary Examiner
Art Unit 3754